

### **Remarks**

Thank you for your ongoing work in connection with this application. Following are Applicant's remarks responsive to the Office Action.

### Amendments

Independent claims 1, 15, 23 and 27 are amended to better define Applicant's binder clip sleeve as an indicia-display device and not as an accessory apparel item. The amendments to claims 1, 15, 23 and 27 better describe Applicant's sleeve in terms of its attachment to the binder clip and relationship of the sleeve to the binder clip handles. Claim 23 adds text regarding the handle structure. New Claims 34 and 35 depend on either claim 1 or 15 and add indicia. The amendments are supported in the Application, for example, at 3:10, 4:20-22, 4:23-28, 5:3-5, 5:9-12, 8:22-24, 8:27-29, 10:15-18, 11:9-11, 12:26 through 13:5 and Figures 1, 2, 3, 5, 10. (references are to page: line). As is apparent, no new matter is added.

### Response to Rejections

#### Rejections under 35 U.S.C. § 102(b)

Claims 1, 3-6, 23, 24, 27, 29 and 30 were rejected under 35 U.S.C. § 102(b). Reconsideration and withdrawal of the rejections is requested in view of the amendments and following remarks.

Claims 1, 3-6, 23, 24, 27, 29 and 30 were rejected under 35 U.S.C. § 102(b) based on U.S. Patent No. 6,327,749 (Antinone). Antinone is an accessory apparel item in the form of a money clip. As is known, money clips are used to organize currency, credit cards and the like and are intended to be placed in the user's trouser pocket. As is also known, a money clip must have smooth, soft outer surfaces to avoid tearing or damaging the user's trousers when, for example, the user walks, runs, dances, sits or squats.

Consistent with this purpose, Antinone's money clip is described as a "soft" cover made of leather, plastic or any flexible flat material. Antinone at 1:40-41, 1:47-49 and 3:11-12. Antinone's soft cover is wrapped loosely around the binder clip and is not attached to the binder

clip body. Antinone's soft cover is held in place by insertion of the handles into respective slits (8) so that each handle is covered. Antinone at col. 2, lines 54-55 and Figures 1-2 and 4-7. As is apparent from the Antinone drawing figures, Antinone's cover is significantly oversized relative to the binder clip.

Antinone's soft cover and cover pockets act like a sheath covering the hard metal binder clip handles and preventing the handles from tearing the user's trousers when tensile forces are applied to the trousers by walking, running, dancing, sitting or squatting. Antinone's significant oversizing of the cover is obviously intended to prevent direct contact between the hard metal parts and sharp edges comprising the binder clip and the soft fabric material comprising the user's trousers.

Amended independent claims 1, 23 and 27 distinguish Antinone at least because two of Applicant's panels are secured to a respective jaw portion and the handles are uncovered. This latter structural feature distinguishes Applicant's indicia-displaying binder clip sleeve from an apparel item intended to be carried in a user's pocket. Antinone is further distinguished because Antinone's money clip has, at most, one panel. Withdrawal of the rejection of claims 1, 3-6, 23, 24, 27, 29 and 30 is respectfully requested.

The rejection of dependent claims 3-6 based on Antinone should also be withdrawn because those dependent claims are directed to a unitary sleeve. See Application at 9:9-13. Antinone lacks any such structure because Antinone's cover is formed by joinder of inner and outer layers (3, 4). Antinone at 2:51-54, Figures 2, 4, 5-7.

Claims 1 and 3-6 were rejected under 35 U.S.C. § 102(b) based on U.S. Patent No. D479,146 (Manley). Manley is a design patent for a money clip, again an accessory apparel item. Manley's technical disclosure is very limited. It is apparent from the design, however, that Manley was concerned about the same issues as was Antinone.

Manley's ornamental design requires three sheath-like cover parts which prevent direct contact between the metal binder clip parts and the user's trousers. All three cover parts are essential as no single part is shown to be optional in any way. All three cover parts must be viewed in their totality because to do otherwise would impermissibly alter Manley and defeat the

purpose of the Manley money clip. Like Antinone, Manley solves the trouser tearing problem created by the metal binder clip handles by inserting the handles into the sheath-like cover pockets thereby partially covering the handles and preventing them from damaging the user's trousers. Also like Antinone, Manley's cover design is significantly oversized relative to the binder clip thereby preventing contact between the binder clip and the user's trousers.

Applicant's claim 1 requires that the handles are uncovered thereby distinguishing Manley. Regarding dependent claims 3-6, Manley Figure 4 shows that the money clip is made of two layers and is not unitary. Withdrawal of the rejection based on Manley is respectfully requested.

Rejections under 35 U.S.C. § 103(a)

All remaining claims were rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. D479,146 (Manley) alone or in combination with other references. Reconsideration and withdrawal of the rejections is requested.

Applicant first notes that Applicant's amendments to independent claims 1, 23 and 27 and independent claim 15 define Applicant's indicia-displaying sleeve as a product which is fundamentally different from an accessory apparel item like a money clip as described above. Applicant's sleeve is for indicia display. Indicia is explicitly claimed in independent claims 23 and 27, and claims 34 and 35. Applicant's sleeve is not intended to be carried in a user's pocket because the binder clip handles are not covered making it likely that the handles could damage a user's clothing. A person of skill in the art would not look to an accessory apparel item when seeking to design a binder clip sleeve for displaying indicia as described and claimed by Applicant.<sup>1</sup>

For at least these reasons, independent claims 1, 15, 23 and 27 (and the dependent claims)

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<sup>1</sup>Consistent with this, the Office has assigned Antinone and Manley to classes different from Applicant's binder clip sleeve. Applicant's binder clip sleeve is classified in class/subclass 40/658 for Card, Picture, or Sign Exhibiting/Clip- or clamp-type holder. Antinone is classified in class/subclass 24/67 for Buckles, Buttons, Clasps, Etc/Paper Fastener and Manley is in class D11/78.1 for Jewelry, Symbolic Insignia, and Ornaments/Money clips.

distinguish Manley. In addition, the independent and dependent claims include other features which distinguish Manley as will now be discussed in connection with the specific claim rejections.

Claims 2, 6-12, 15 and 17-20 were rejected under 35 U.S.C. § 103(a) based solely on Manley.

Regarding claims 2, 10, 11, 15 and 17-20, the Examiner very correctly noted that Manley's panels are oversized relative to the binder clip. This structural difference underscores the fundamental difference between Applicant's binder clip sleeve and Manley's money clip (as well as the Antinone money clip) as noted above. Manley's money clip must be oversized and must cover the binder clip parts which could damage the user's trousers. Oversizing of Manley's money clip is not just a mere change in the size of a component done as a matter of convenience, it is a matter of necessity. Therefore, claims 2, 10, 11 and 15, which call for a more fitted sleeve, distinguish Manley's money clip which is required to have different structure consistent with Manley's fundamentally different purpose. Since claims 17-20 depend on claim 15, those claims should also be viewed as non-obvious.

Regarding claim 6, that claim is directed to a unitary sleeve which is self supporting. Manley does not suggest such a configuration as is apparent from the inner and outer layers in Manley Figure 4. And, the material used in Manley is not known so it is not known whether the material is self supporting.

Regarding claim 8, there is no suggestion that Manley is made of paper or that paper could be used as a material which would be used to cover a money clip nor is there any reason to believe that paper would prevent damage to the user's clothing as required in a money clip accessory apparel item.

Regarding claim 9, the use of film material is not consistent in any way with a money clip because those materials would not prevent damage to the user's trousers.

Claims 14 and 22 were rejected under § 103(a) based on Manley and U.S. Patent No. 5,766,795 (Will). It is acknowledged that Will describes one embodiment with a transparent film layer for a label on a dry cell battery. Will at col. 3, lines 18-28 and Figure 5. However, there is

nothing in the combination of references which fairly discusses or suggests anything close to a light transmissive sleeve over a binder clip sleeve. This would appear to be a hindsight-based rejection utilizing the teachings of Applicant's invention.

Claim 13 was rejected under § 103(a) based on Manley and U.S. Patent No. 5,522,586 (Bennett). Applicant does not claim to have discovered perforations. However, Manley does not show any perforations and does not suggest any reason to use perforations in a money clip. The material used to make the Manley money clip is not known so there is no reason to believe that perforations would be of interest. Moreover, adhesive is involved in claim 13 by way of claim 7 and there is no teaching or suggestion of adhesive in combination with perforations in the context of any money clip or binder clip sleeve.

Claim 21 was rejected under § 103(a) based on Manley, Antinone and U.S. Patent No. 5,839,215 (Lasprogata). Dependent claim 21 distinguishes these references at least because it is based on claim 15. The money clips of Manley and Antinone are oversized as one would expect for a money clip. And, there is no reason to believe that the money clips of Manley and Antinone could or should be modified with raised or indented elements as in claim 21.

Claims 23-25 and 27-33 were rejected under § 103(a) based on Manley and Antinone. Antinone does show a logo (9). However, Antinone and Manley are both money clips which, as discussed above, require different physical structure to accomplish a purpose which is different from that claimed by Applicant. The amendments to claims 23 and 27 exclude the cover structure required by both Antinone and Manley and frame Applicant's product as an indicia-displaying device, which is a field separate and apart from accessory apparel items like money clips. Reconsideration is respectfully requested.

The rejection of claim 26 should be reconsidered and withdrawn for the reasons stated in connection with claims 14 and 22 above.

The rejection of claim 28 should be reconsidered and withdrawn for the reasons stated in connection with claims 2, 10 and 15 above.

It is believed that the foregoing amendments and remarks fully distinguish Manley and allowance of the claims is respectfully requested. While not believed to be necessary for claim

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Page 15 of 15

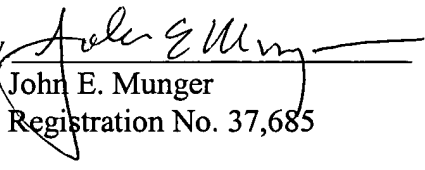
allowance, and without waiving any of the foregoing arguments, Applicant further submits his declaration under 37 C.F.R. §1.131 demonstrating invention before Manley's filing date. It is apparent that if Manley is removed as a reference, all of the claims rejected in whole or in part based on Manley should be allowed.

### Conclusion

The Examiner is invited to call the undersigned if that would be of assistance in resolving any outstanding issue regarding this application. The Commissioner is authorized to debit deposit account 10-0270 to pay for the two additional dependent claims and any other amounts due in connection with this paper. Kindly notify the undersigned in the event that the deposit account is debited or credited.

Respectfully submitted,

By

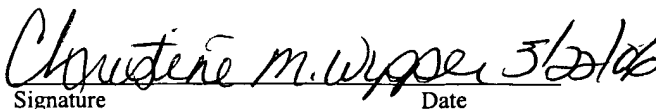
  
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